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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,554	06/19/2006	Mineyuki Kubota	292333US0PCT	9827

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BROOKS, CLINTON A

ART UNIT	PAPER NUMBER
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1621

NOTIFICATION DATE	DELIVERY MODE
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06/17/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/583,554	Applicant(s) KUBOTA ET AL.	
	Examiner CLINTON BROOKS	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>f</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 25, 2010 and March 23, 2010 has been entered.

Status of Claims

In the response received January 25, 2010, Applicants amended independent claims 1, and 12. Claims 1-14 are pending, claims 7-11 stand withdrawn.

Response to Applicants Arguments/Amendments

The non-statutory double patenting rejection is withdrawn because application no. 10519934 ("the '934 application") stands abandoned.

In view amendment, Applicants' arguments are moot.

In view of the amendment, the 102(b) and 102(a,e) rejections of record are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

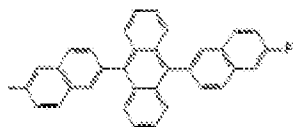
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by EP1009044 (“the ‘044 publication”, made of record on the IDS received January 22, 2009).

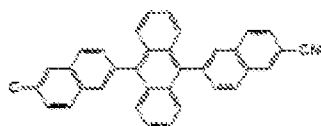
The ‘044 publication teaches at least an overlapping genus, and at least the following anticipatory species:



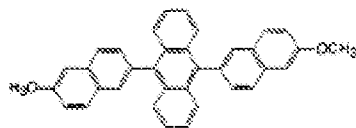
Compound 41

In this case the substituents at the 9th and 10th positions are different from each other.

In addition, the ‘044 publication teaches the following species (page 19):



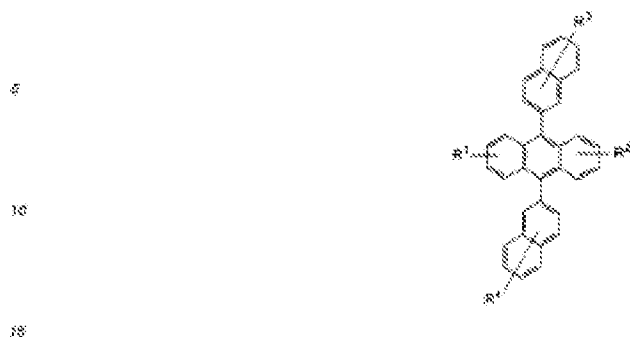
Compound 42



Compound 43

Still further, the '044 publication teaches at least the following subgenus (p 37):

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20 wherein:

substituents R¹, R², R³ and R⁴, are each individually hydrogen, or alkyl of from 1 to 24 carbon atoms, aryl or substituted aryl of from 5 to 20 carbon atoms, or heteroaryl or substituted heteroaryl of from 5 to 24 carbon atoms; or fluorine, chlorine, bromine, or cyano group.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1-6, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-11323323 (“the ‘323 publication”, published November 26, 1999).

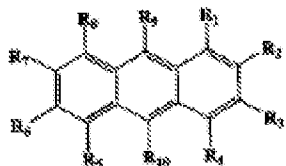
The ‘323 publication teaches (machine translation previously made of record) for example the genus below:

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[Claim 1] A luminescent material characterized by what is shown in a following general formula (1) which makes an anthracene ring a basic skeleton.

[Chemical formula 1]

式 (1)



($R_1 - R_8$ show a hydrogen atom, an alkyl group, and an alkoxy group among a formula.) R_9 and R_{10} express a naphthyl group which may have a substituent chosen from an alkyl group and an alkoxy group, an anthryl group, a phenanthryl group, a biphenyl group, and a terphenyl group.

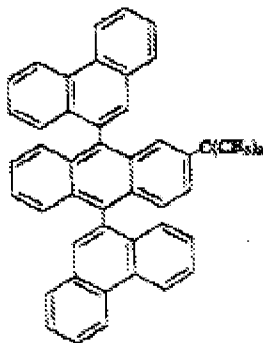
Further, the '323 publication teaches the R_9 and R_{10} expresses a naphthyl group which may have a substituent chosen from an alkyl group and an alkoxy group; an anthryl group, a phenanthryl group, a biphenyl group, and a terphenyl group. This interpretation is supported by the examples.

Examples of species include:

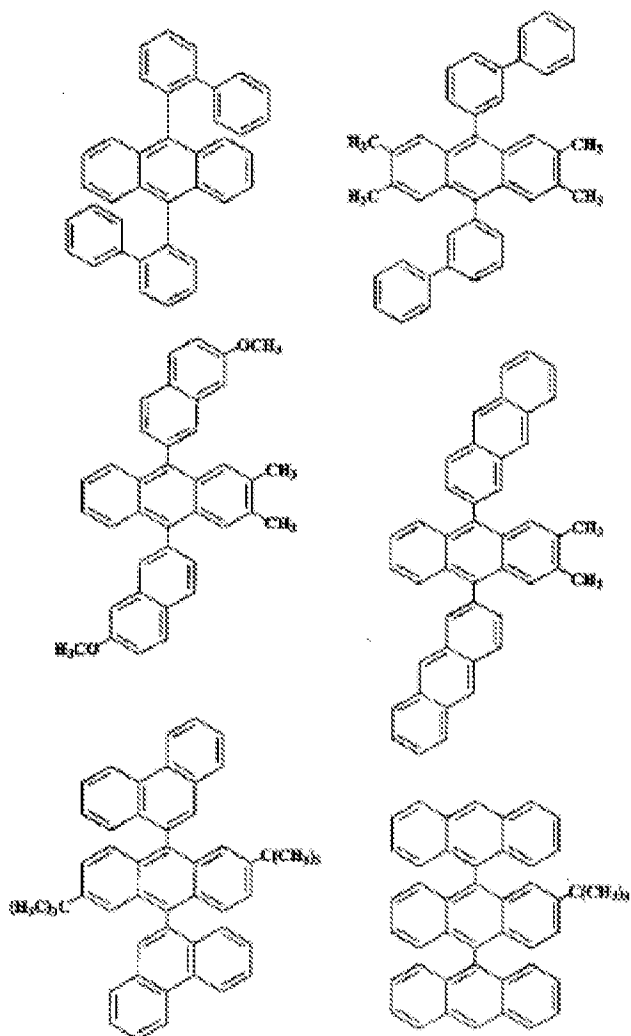
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【0041】

【化13】



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{0031}

[Chemical formula 10]

All of the examples of the '323 publication that have substituents at the 9th and 10th position of the anthracene core have the same substituent.

Thus, the '323 publication fails to teach an example wherein the substituents at the 9th and 10th positions are different.

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However, the genus teaches that a limited number of different groups can be placed in these positions and an overlapping/encompassing genus which has the same utility as the instant application.

It would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to start with the specie of paragraph [0041] and substitute one group for a 2-naphthyl group as depicted in the specie of paragraph [0031] because structurally similar compounds are expected to have similar properties. One skilled in the art would expect success in the substitution because the genus teaches that the groups being substituted have similar properties. Further, since both of these groups are exemplified in species they are preferred groups.

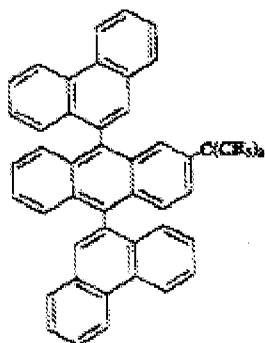
Claim 1-6, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-11323323 (“the ‘323 publication”, published November 26, 1999) in view of US2003/0068524 (“the ‘524 publication”, made of record in previous office action).

The ‘323 publications teaches as disclosed above and which is incorporated by reference herein. For example the ‘323 publication teaches the following specie which contains a 9-phenanthryl group:

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【0041】

【化13】



Further, the '323 publication teaches that these compounds have utility in organic light emitting devices (title).

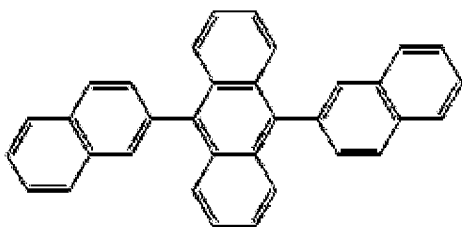
The '323 publication fails to teach a specific compound as recited in claim 14.

The '524 publication teaches that the compound in paragraph [0064] is one of two preferred compounds.

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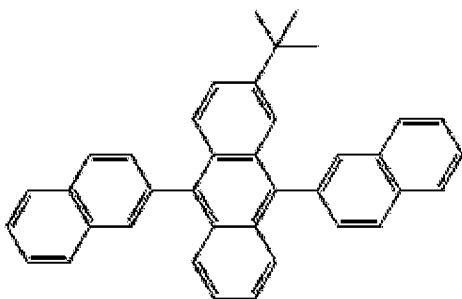
[0061] Preferred host materials for the blue luminescent layer of this invention include:

[0062] a) ADN

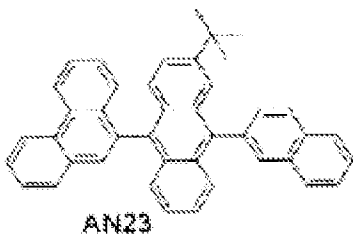


[0063] or

[0064] b) tertiary butyl AND (TBADN)



One of the species of claim 14 is shown below for reference:



It would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to substitute the naphthyl arm of the specie taught by the '524 publication with one of the 9-phenylnaphthyl arms of the specie taught by the '323 publication to

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arrive at the specie AN23 recited in claim 14 because the '524 publication teaches that the naphthyl containing structure is preferred. One would expect success in the substitution because the art teaches that these molecules are used for the same purpose.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLINTON BROOKS whose telephone number is (571)270-7682. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL SULLIVAN can be reached on (571)272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cab

/Daniel M Sullivan/

Supervisory Patent Examiner, Art Unit 1621